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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/809,620	02/05/1998	VERNOIS GOULVEN		7803

7590 02/16/2006

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FRANCE

EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/809,620

Applicant(s)

GOULVEN, VERNONIS

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/4/99; 6/27/01 and 6/28/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 14, 15, 18, 19, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 14, 15, 18, 19, 44 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: _____

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendments filed on 28 June 2001; 27 June 2001 and Nov. 4, 1999.
2. In the amendment filed by the applicant on 27 June 2001, applicant has filed a marked-up copy of the specification, a corrected drawings and a page of claims. It is also noted that applicant has requested some changes to the specification as can be seen in page 1 of the communication filed on 28 June 2001. In the amendment filed on Nov. 4, 1999, applicant has made changes to the specification, the drawings and the claims. It is noted that all of the amendments filed by the applicant do not comply with the requirements as set forth in rule 37 CFR 1.121. In the spirit of cooperation, the papers filed on all amendments have been considered and yields the following conclusions.
 3. A review of the papers filed by applicant on June 27, 2001 and June 28, 2001 has resulted as follow:

First, the marked-up specification contained five pages in which the reference thereof "US08/809620 (TE 20010528c)" appeared on the top and right corner of the first page, is temporarily used as a specification of the application. It is noted that the requested changes as listed in the first page of the communication filed on 28 June 2001 have not been entered because it is unclear about the locations, i.e., pages and lines, contained the materials which applicant requests to change. Applicant still has an opportunity to amend the specification by making the changes to the specification in

response to this Office action. It is also noted that applicant must provide a clean version of the specification in response to this Office action. *Applicant should further note that the new (clean) specification must be accompanied by a statement that it contains no new matter.*

Second, in the marked-up copy of the specification, applicant has failed to file an abstract of the application. The abstract filed by applicant on Nov. 4, 1999 is used as the abstract of the application. Since the abstract is objected to for the reason(s) provided below, applicant must file a new abstract in response to this Office action.

Third, in the communication of 27 June 2001, applicant has made changes to the drawings as originally filed. The new drawings as filed now contain two sheets of figures 1-10.

Fourth, regarding to the claims, it is noted that in the amendment/communication filed on 4 Nov. 1999 and 28 June 2001, applicant has amended claims 1, 14, 15, 18 and 19; added claims 44 and 45 and canceled claims 2-13, 16-17, 20-43. It is also noted that the amendments to the claims do not comply with the requirements of set forth in 37 CFR 1.121 because applicant has not showed the changes to the claims. However, in the spirit of cooperation, the claims 1, 14-15, 18-19 and 44-45 as filed are examined in this Office action.

Applicant is respectfully reminded to review the MPEP and the rule 37 CFR 1.121 which a copy of the rule is attached with this Office action. See three pages having page numbers as of R-87, R-88 and R-89. Applicant should note that any

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amendment form now on which does not comply with the rule would not be entered into the application.

In the light of details as provided above, the application with the specification having five pages filed on 27 June 2001, the abstract filed on 4 Nov. 1999, the drawings contained figures 1-10 filed on 27 June 2001, and the (pending) claims 1, 14-15, 18-19 and 44-45 filed in the amendment/communication of 28 June 2001 are examined. If there is any part/section which is missed or inaccurate as mentioned above, the applicant is respectfully invited to state or point out in the response to this Office action.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

5. The objection to the Oath/Declaration as set forth in the Office action of 8 July 1999 is now overcome by the filing of the new Oath/Declaration by the applicant on 5 Nov. 1999.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The reference "5.5" stated in the specification, in page 5 is not shown in at least one figure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to because the use of the references "7, 8, and 9" in figure 1 is unclear. It is unclear why applicant has used the same reference for two different items. In other words, it is unclear about the structural relationship between the upper section and the lower section of the device shown in figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

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the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. The abstract of the disclosure is objected to because it contains the term 'said' 9see abstract on line 3. Further, the references "45" and "46" referred to in the abstract are not mentioned in the specification and the drawings. Correction is required. See MPEP § 608.01(b).

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

10. The disclosure is objected to because of the following informalities: a) page 2: line 6, "centrals" is a typo; b) page 2: line 19, the brief descriptions of figures 8-10 are unclear. Applicant should provide a brief description for each figure; c) Page 2: lines 2, 3, 23, 24, 28, 29, 30, 32 and 33, and page 4: lines 2, 4, 6, and 8, the use of the references "3" and "4" are unclear and also inconsistent. Applicant should note that the reference "3" is used to refer to a liquid film as can be seen on line 2; however, on each of lines 23-24, 28-30 and 33, applicant has used the reference "3" for a liquid. It is also noted that the reference "4" is used for a liquid as can be seen on lines 3 and 23; d) Page 3: lines 6 and 8, the use of the terms for the reference "4" in page 3, lines 6 and 8 is unclear. In particular, on line 6, applicant has used terms "main liquid" for reference

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"4"; however, on line 8, the reference '4' is used for "rotating liquid". Applicant should be consistent in use of the language for the same reference; e) Page 3: lines 12 and 34, the reference "7" is used to refer to two different items, i.e., a surface design on line 12 and coils on lines 34. Applicant should be consistent in use of the language for the same reference; f) Page 4: line 18, "according to claim," should be deleted; g) Page 5: lines 14-15, the description thereof "Two examples of arrangement (fig. 43) show parallel membranes and back to back membranes." Is unclear. Applicant should note that the application after amendment of 27 June 2001 has only ten figures, labeled as figures 1-10. The application does not have any figure labeled as fig. 43. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

11. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification has not provided a proper antecedent basis for the feature thereof "that a ring...is fixed in a removable way on the revolving container" recited in claim 45, lines 1-3. Applicant should note that while the specification in page 4 discloses the formation of a ring (10) with respect to the container (5) (see page 4, lines 23-29); however, the specification has never disclosed that the ring is fixed in a removable way on the container as claimed (Note: Examiner's emphasis).

Claim Objections

12. Claims 1, 15 and 45 are objected to because of the following informalities.

Appropriate correction is required.

- a) In claim 1: on line 2, the use of the parenthesis for the terms/functions in the claim makes the claim indefinite because it is unclear whether the terms/functions inside the parenthesis are positively terms/functions of the device claimed. Should "membranes (called membranous mirror and actuating membrane)" (line 20) be changed to --membranous mirror and actuating membrane-- or other suitable terms to make clear the feature claimed?
- b) In claim 15: on line 3, "centred" is a typo;
- c) In claim 45: on line 1, "materials" should be changed to --material--; on line 2, "revolving" should be changed to --rotating-- (see claim 18 on line 3), and on line 3, "the said ring" should be changed to --said ring--.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite because it is unclear about the structural relationship between the actuating membrane and the membranous mirror as claimed. In particular, it is unclear how the so-called "formation of concentric circular

undulations obtained by a succession of centred (centered ?) distorsion alternately concave and convex" make the actuating membrane and the membranous mirror as the so-called "quasi plane". It is also unclear about the structure of the device claimed by the feature thereof "the quasi plane one thus obtained rolled up on itself according to a diameter".

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1, 18-19, 44 and 45, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hutchison et al (U.S. Patent No. 5,237,337).

Hutchison et al disclose a method and apparatus for producing a mirror. The apparatus as provided in columns 3-4 and shown in figure 2 comprises a concave membrane element (22) and a concave membranous reflecting element (26) wherein the elements (22) and (26) are independent from each other. It is noted that the membrane element (22) acts as an actuating element for the membranous reflecting element (26). The support for the feature that the two elements (22) and (26) are independent to each other is found in the method of making the mirror as provided in columns 4-8 in which Hutchison et al teach the formation of the membrane element (22) from a manufacture side and then the membrane element is carried to a remote location so that the membranous

reflecting element (26) is installed onto the membrane element (22) by pressure.

It is noted that the shape of the reflecting element is controlled by the monitor the process of application or coupling the pressure into the space/distance between the two elements. See column 3. It is also noted that each of the elements comprises a central hole/aperture formed in the middle so that a hub (28) is able to pass therethrough. See column 3, for example.

Regarding to the features as recited in the present claims 18 and 45, it is noted that the method and apparatus for producing a mirror which comprises a concave membranous reflecting element and a concave actuating membrane independent from each other as provided by Hutchison et al also disclose the use of a ring (16) for supporting the two membranous elements. See columns 3-4 and figs. 2-3. However, Hutchison et al do not state that the material of the elements are made by liquid deposited on a rotating container. However, it is noted that the deposit of material in a liquid of a rotating container as claimed is directed to a method step and such a method step recited in an apparatus claim is not given a patentable weight.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchison et al in view of Hayes et al (U.S. Patent No. 5,644,322)

The method and apparatus for producing a mirror which comprises a concave membranous reflecting element and a concave actuating membrane independent from each other as provided by Hutchison et al also disclose that the actuating membrane is made by a material having memory shape and the membranous reflecting element is made by plastic. In other words, in columns 4-8, Hutchison et al teach that the element (22) is made by plastic and has deformable feature. The element (22) after produced is able to carry from the manufacture side to a remote location by placing the element into a mandrel membrane assembly. The element will recover its shape after it releases from the mandrel membrane assembly at the remote side. Regarding to the membranous reflecting element, Hutchison et al state that the element made by a material having flexible feature. See column 3, for example. While Hutchison et al do not clearly state that the material used to make the flexible reflecting element has a shape memory; however, it would have been obvious to use a material having shape memory for making the flexible mirror because the use of such material is known to one skilled in the art as can be seen in the system provided by Hayes et al. In particular, Hayes et al disclose a reflector made by flexible material which material has a shape memory. See columns 4-5. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the mirror provided by Hutchison et al by using material having shape memory as

suggested by Hayes et al for the purpose of recovering the shape of the mirror when external factor such as pressure or deformation is removed.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

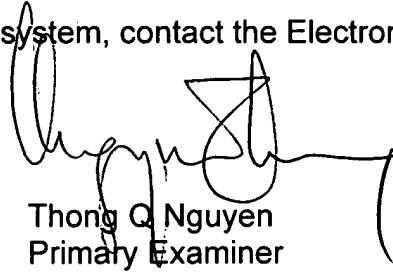
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
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affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.117 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.118 [Reserved]

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.119 [Reserved]

[32 FR 13583, Sept. 28, 1967; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.121 Manner of making amendments in applications.

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section.* A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document.* Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes

(e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing

in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented, canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

(d) *Drawings:* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet". Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet". All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (*e.g.*, amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) *Amendments in provisional applications.* Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (d) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]